

Remarks

The present Amendment is in response to the Office Action of June 28, 1994 in the above referenced application. In that Office Action, claims 1-15 and 17-21 were examined. Claims 16 and 22-31 were withdrawn from further consideration by the Examiner. Applicant acknowledges that claims 16 and 22-31 are withdrawn, subject to Applicant's proceeding on these claims with a continuation application.<sup>1</sup>

Of the examined claims, claims 1-8, 11-13, 17, 18 and 20 were rejected over U.S. Patent No. 4,169,169 to Kitabatake under 35 U.S.C. §102. Claims 9, 10, 14-15, 19 and 21 were rejected over Kitabatake in view of U.S. Patent No. 4,024,287 to Golchert under 35 U.S.C. §103. Claims 2, 5-8 and 17-21 were rejected under 35 U.S.C. §103 over Kitabatake in view of U.S. Patent No. 4,490,410 to Takiyama et al.

In this Amendment, Applicant has amended claim 1 to clearly recite the spreading of a quantity of a viscous surface preparatory composition onto the area to be covered to form a viscous layer that cures into a stable layer adhered to the surface. Claim 1 is also amended to include the processing steps of former claims 2 and 5, now canceled. This method, now claimed by claim 1, is not believed shown in Kitabatake alone nor in combination with any other cited reference.

Specifically, Kitabatake discusses in its background section the method of decalcomania wherein a gelatin film layer having

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<sup>1</sup> In paragraph 6 of the Office Action, the Examiner indicated that claims "19" and "22-31" were withdrawn. This is believed to be a typographical error since claim 19 is properly within the elected Group I while claim 16 was in the non-elected Group II.

a decorative pattern thereon. The pattern and decorative film layer is simultaneously transferred onto the skin to produce the decorative appearance. Kitabatake identifies the use of such a layer as being disadvantageous. Rather, Kitabatake prefers to spray the surface (an area of human skin) with a solvent or, preferably, spray the design elements of his pattern sheet with the solvent and then transfer the pattern.

While Kitabatake specifically wants to avoid a transfer layer, Applicant acknowledges that Kitabatake discloses the possibility of including a very small amount of resin (3% to 7% by weight) in monohydric alcohol as his transfer solution. Kitabatake then identifies that an undercoating film would be formed for the transferred pattern. See, Column 5, line 62- Column 6, line 6.

The Examiner may appreciate that the inclusion of such a minor amount of resin would not lead to a viscous material when dispersed in 93% or more by weight of alcohol. Indeed, this interpretation can be gleamed when Kitabatake's disclosure since his transfer solution is to be sprayed from a can onto the surface area. Viscous materials do not adapt themselves to such spray cans so that the ordinarily skilled artisan would not read Kitabatake as disclosing the use of a viscous layer forming material. Thus, by the inclusion of such recitations in claim 1 to more clearly define the invention, claim 1 is now believed to be distinguished over the Kitabatake reference.

Nor does the combination of either the reference to Golchert or the reference to Takiyama et al add anything to the Kitabatake reference in this regard. Golchert is cited by the Examiner

simply to show the use of tracing of a pattern at the time of transfer. With respect to Takiyama et al, the ordinarily skilled artisan would not be lead to combine any teaching found in Takiyama et al with Kitabatake. Kitabatake specifically wants to avoid any gelatin-like layer. Indeed, the Takiyama process appears to be an industrial process to place an embedded design on a hardened layer formed over construction materials such as processed wood products (plywood, chip board, particle board, etc.) metals, stones, fabrics, etc.

Turning to claim 17, Applicant has amended claim 17 to include recitation that the preparatory layer is applied as a viscous preparatory layer. In addition, claim 17 now clearly recites that the pre-printed design is in a water-soluble medium while the surface preparatory composition is water-based.

In the addition to the discussion of the lack of any viable teaching of a viscous layer forming material usable either disclosed in or usable with the Kitabatake process, neither Kitabatake nor Takiyama et al show the use of a water-soluble ink medium with a water-based preparatory layer. Indeed, Takiyama et al specifically teaches away from the use of such water-soluble materials noting that water-soluble inks are difficult to create and retain the printed decorative patterns in industrial products. See, Column 2, lines 31-35. Kitabatake also seeks to avoid any water-soluble transfer solutions or ink since they may wash off. Rather, Kitabatake specifically discloses that the ink solvent is an organic solvent, preferably monohydric alcohol. See, Column 4, lines 37-63. The Kitabatake transfer solution is according, monohydric alcohol, as noted

above, which may contain a small amount of resin.

While Applicant agrees that water soluble inks are known in the prior art, and are specifically shown disclosed in the Golchert reference, a skilled person would not use such water-soluble materials in either the Kitabatake or Takiyama et al processes in view of their specific teaching not to use such soluble mediums or transfer solutions.

Newly added claim 32 likewise is not disclosed in the prior art. In addition to the matters discussed above, claim 32 is claim 18 rewritten in independent form to recite the specific composition, the group of materials from which the preparatory composition is selected to be water-based animal glues (animal or non-animal), water-based paints and egg white. None of the references show these materials being used to produce a surface preparatory layer that has an initial state wherein a pattern is transferred and which cures into a final state. Accordingly, claim 14 has been canceled.

With the addition of newly added claim 32, an additional filing fee in the amount of \$37.00 for the additional independent claim is enclosed. No "extra-claim" fee is required due to the cancellation of claims 2, 5, 14, 18 and 19. Accordingly, our check no. \_\_\_\_\_ in the amount of \$37.00 is enclosed.

Based on the foregoing, Applicant believes that the present application is in condition for allowance and action to that end is courteously solicited. Applicant's counsel intends to visit the Washington, DC area during the first week in October, and requests the opportunity to have a personal interview with the Examiner on this case at that time. It is hoped that remaining

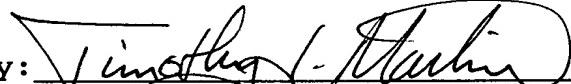


issues, if any there be, can be resolved at that time.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the foregoing AMENDMENT including check no. 8215 in the amount of \$37.00 for the extra independent claim is being deposited with the United States Postal Service as FIRST CLASS MAIL for delivery in a postage pre-paid envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this 27 day of September, 1994.

